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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,173	04/01/2004	James F. Zucherman	5910-194	7894
65901	7590	02/22/2008		
COATS & BENNETT/MEDTRONICS 1400 CRESCENT GREEN SUITE 300 CARY, NC 27518			EXAMINER PHILOGENE, PEDRO	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 02/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/816,173	Applicant(s) ZUCHERMAN ET AL.	
	Examiner Pedro Philogene	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-13, 15, 17-21, 26, 29, 36, 37, 40-51 and 62-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13, 15, 17, 26, 37, 40-51, 62-65 and 2936 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/20/04, 5/19/05, 5/18/06, 1/31/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election with traverse of FIGS 1-7 in the reply filed on 1/15/08 is acknowledged. The traversal is on the ground(s) that claims 10, 25 do not belong to the elected species of FIGS.1-7 and claims 18, 19, 21, 36, 37, 40, 41, 62 relate to the species of FIGS.1-7. This is found persuasive and the requirement is deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8,11-13,15,17-19, 26, 36-37, 40-45,48-51,62-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Zucherman et al. (6,190,387).

With respect to claims 1,11,18, 42, Zucherman et al disclose a device for relieving pain associated with the vertebrae of the cervical spine and surrounding tissues and structure, by maintaining and/or adding distraction between adjacent cervical vertebrae when positioned between the spinous processes of adjacent cervical vertebrae, without detracting from the rotation of the cervical vertebrae relative to each other, the implant comprising a wedge-shaped spacer (804,904...), a wedge-shaped wing (810,910...), a wedge-shaped distraction guide (808, 908...) the spacer including a second wing (824, 924...)the spacer can rotate as best seen in FIG.92a, The wing is continuous with the spacer, the distraction guide is continuous with the spacer, as best

seen in FIGS.79-87; the spacer having smooth surface, rounded edges to create a wedge for varying distraction of adjacent cervical vertebrae; asset forth in column 21, lines 24-30; the spacer has a wedge shape when urged between the spinous process of the adjacent cervical vertebrae, allows flexion but not extension of the neck and create a contact surface with the bone of the spinous process that increases as the wedge-like spacer moves anteriorly, whereby the implant distributes the distraction forces on the spinous proceses over the contact surface, because of the wedge shape of the implantthe wings are angle outward relative to each other; asset forth in column 25, lines 29-37, the spacer s elongated in cropss-section and the first wing is elongated in the same direction that said spacer is elongated, and the distraction guide extends from the spacer; as best in FIGS.84, 92, 93.

With respect to claims 2-8, 12,13,15,17,19,26, 43-51,63-65, Zucherman et al disclose all the limitations, asset forth in column 18, lines 39-67, columns 1-22, lines 1-67 and as best seen in FIGS.79-117.

With respect to the method claims, the steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29,46,47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucherman et al. (6,190,387) in view of Zdeblick et al. (6,383,191).

It is noted that Zucherman et al did not teach of a Ring having a hole; as claimed by applicant. However, in similar art, Zdeblick et al evidence the use of a ring with a hole to receive a sleeve therein. Therefore, given the teaching of Zdeblick et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ring of Zucherman et al., as taught by Zdeblick et al, by providing a hole in the ring to accommodate the spacer.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,224,599	5-2001	Baynham et al
6,299,642	10-2001	Chan

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
February 11, 2008